

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte, STEVEN D. IMS, YONGCHENG LI, YIH-SHIN TAN, and
BRIAN WEBB

Appeal No. 2006-2303
Application No. 09/442,791
Technology Center 2100

Decided: February 16, 2007

Before JOSEPH F. RUGGIERO, ALLEN R. MACDONALD, and
JEAN R. HOMERE, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, 36, and 37.

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THE INVENTION

The disclosed invention pertains to a method and system for legacy host system hot link modeling and navigation.

Representative claim 1 is illustrative:

1. A method in a data processing system for navigating screens in a legacy host system, comprising the steps of:
 - receiving, from a client, a request for a host screen;
 - navigating to the host screen;
 - retrieving the host screen;
 - formatting the host screen into a formatted host screen from a non-markup language to a markup language, wherein the formatted host screen displays selectable links to other screens within host system;
 - and
 - sending the formatted host screen to the client.

THE REFERENCES

The Examiner relies upon the following references as evidence of unpatentability:

Himmel	US 6,167,441	Dec. 26, 2000
Tada	US 6,237,040	May 22, 2001

THE REJECTION

The following rejection is on appeal before us:

1. Claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Himmel in view of Tada.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and considered, in reaching our decision, the Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after considering the record before us, that the evidence relied upon by the Examiner does not support the Examiner's rejections of claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, 36, and 37. Accordingly, we reverse.

MOTIVATION

With respect to all claims on appeal, Appellants argue that the Examiner has failed to provide a proper motivation for combining the Himmel and Tada references (Br. 5; Reply Br. 2). Appellants argue that the Examiner is essentially stating that a reference that generally teaches accessing Internet content could be combined with any other reference that teaches accessing Internet content, regardless of the problems identified and solved in the different references (Br. 5).

Appellants note that Himmel is directed towards providing customized Internet content to a requesting client using an intercepting agent that detects the client device capabilities and redirects the client request to a URL appropriate for the client device type (Br. 6). Appellants argue that there is no need, let alone any suggestion, to convert non-markup language to a markup language to customize the presentation of a selected web page in Himmel (*id.*).

Appellants note that Tada is concerned with providing a means to enable the automatic processing of non-HTML data (e.g., e-mail data), regardless of whether the data to be processed is requested by the user (Tada, col. 1, ll. 40-43). Appellants note that when a user requests a web page, Himmel provides the user an *immediate* response that is a customized version of the requested data. Appellants note that data converted from non-markup language to markup language in Tada is provided to the user in a *deferred* manner where the converted data is provided to the user via a *link* that the user must *select* to access the data (emphasis added). Appellants assert that there is no need, let alone any suggestion in Tada to provide a

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client-tailored web page of the requested data to match the client's capabilities (Br. 6-7).

Appellants further assert that the combination proffered by the Examiner is the result of impermissible hindsight reconstruction using Appellants' own disclosure as a guide. Appellants argue that neither Himmel nor Tada teaches the problem of the present invention (i.e., accessing and navigating through various screens of a legacy host system without requiring knowledge of service specific commands) (*id.*).

The Examiner disagrees. The Examiner acknowledges that the Himmel reference fails to teach the limitation of formatting the host screen from a non-markup language. The Examiner notes that Himmel recognizes that FTP (file transfer protocol) and Gopher sites exist for access on the Internet (col. 1, ll. 30-31). The Examiner notes that Himmel also provides support for any browser, even "back level" browsers that may not support a particular language (or language version) that may have become prevalent after the browser was written (col. 7, ll. 55-60). The Examiner notes that Himmel further discloses that Internet protocols other than HTML can be used and adapted to the teachings of the invention (col. 9, ll. 54-58) (Answer 8-9).

With respect to the secondary reference, the Examiner notes that Tada teaches a system and method to enable the automatic processing of non-HTML data such as e-mail data even if the user terminal has a browser that only supports HTML (*see Abstract; also see col. 1, ll. 45-50*). With respect to Appellants' argument regarding Himmel's "immediate response" and Tada's "deferred access," the Examiner responds that providing an

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“immediate response” or “deferred access” are not issues of concern in Himmel and Tada, nor is such language found in the instant claims. Therefore, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Himmel with the teachings of Tada so that non-HTML files such as e-mail could be accessed by a HTML browser since Himmel recognizes the existence of non-HTML data and also since retrieving e-mail represents a typical task in the Internet browsing experience (Answer 8-10).

At the outset, we note that to reach a proper conclusion under §103, the examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the examiner to ascertain whether the Examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn* 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006). With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d

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1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has also noted: “[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact.” *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004) (internal citations omitted).

In the instant case, we note that the focus of Himmel’s invention is to customize web pages to accommodate differences in the capabilities of the display, memory, and processor associated with a given client device, such as a handheld device that lacks the resolution and screen size of a standard computer display (col. 3, l. 66 through col. 4, l. 13). In contrast, Tada is directed to an entirely different purpose of processing non-HTML data, such as e-mail, with a WWW browser (col. 1, ll. 45-49). After careful consideration of all the evidence before us, we agree with Appellants that the Examiner has failed to provide a rationale or convincing line of reasoning that sufficiently explains why an artisan having knowledge of Himmel would have found the claimed invention obvious in light of the teachings of Tada. In particular, we agree with Appellants that there is no need, let alone any suggestion in Himmel, to convert a non-markup representation of data to a markup language representation.

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Furthermore, we do not see how an artisan having knowledge of Himmel would have been reasonably motivated to look to Tada to achieve the advantage proffered by the Examiner without relying upon the instant claims as a template or guide. We note that our reviewing court has clearly stated:

[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.

ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

In the instant case, we conclude that the Examiner has impermissibly used the claimed invention as a template or guide in order to piece together the teachings of Himmel and Tada in an effort to create a mosaic of such prior art to argue obviousness. Therefore, we agree with Appellants that the Examiner has failed to meet the burden of presenting a *prima facie* case of obviousness. Accordingly, we will reverse the Examiner's rejection of representative claim 1. In addition, we will reverse the Examiner's rejection of independent claims 12, 23 and 34 for the same reasons discussed *supra* with respect to claim 1. Because we have reversed the Examiner's rejection of each independent claim, we will not sustain the Examiner's rejection of any of the dependent claims under appeal.

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DECISION

We will not sustain the Examiner's rejection of any claims under appeal. Therefore, the decision of the Examiner rejecting claims 1, 3-8, 10-12, 14-19, 21-23, 25-30, 32-34, 36, and 37 is reversed.

REVERSED

tdl

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